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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/823,814	04/14/2004	Tsutomu Okada	17614	5629
23389 7590 03/03/2008 SCULLY SCOTT MURPHY & PRESSER, PC 400 GARDEN CITY PLAZA SUITE 300 GARDEN CITY, NY 11530				
EXAMINER				
PAPAPIETRO, JACQUELINE M				
ART UNIT		PAPER NUMBER		
3739				
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**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

### Office Action Summary

**Application No.**

10/823,814

**Applicant(s)**

OKADA, TSUTOMU

**Examiner**

JACQUELINE PAPAPIETRO

**Art Unit**

3739

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 06 February 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1 and 7-10 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1 and 7-10 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/CDC)
- Paper No(s)/Mail Date \_\_\_\_\_

- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

**DETAILED ACTION**

***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1 and 7-10 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The limitation "partially blocking flow from of the liquid fed in the vicinity of the distal end portion by the liquid feed portion" in the last two lines of claim 1 is unclear and confusing. The claims have been examined as best understood by the examiner.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claims 1 and 7-9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kokai (Publication No. 4-329944) in view of Rexroth et al (US 4943290).

Regarding claims 1 and 7, Kokai discloses a radio knife (1) comprising: an electrically insulating flexible sheath (2) having one flow channel inside (see the channel in Fig 1), a

distal end portion and a proximal end portion, the distal end portion of the sheath having a distal opening (13) and an axis; a support member (4) which closes the distal opening of the sheath (Fig 4), the support member having a slide hole with diameter smaller than that of the distal opening extending along the axis thereof (Fig 4); an operating wire (14) axially movable in the sheath (paragraph 0013 lines 8-14); an electrode portion (6) which has a distal end portion and a proximal end portion and of which least a part forms a rod-shaped portion (Fig 4), the proximal end portion of the electrode portion being coupled to the operating wire (paragraph 0013 lines 4-6), the rod-shaped portion being passed through the slide hole for axial projection and retraction (X, shown in Fig 5); a control section (3 and 15) which is provided on the proximal end portion of the sheath (Fig 5) and controls the operating wire to project and retract the electrode portion in the axial direction (paragraph 0013 lines 8-14), the control section having a high-frequency current supply portion (paragraph 0010 lines 6-8) which supplies a high-frequency current to the electrode portion (paragraph 0011 lines 9-12); a liquid feed portion (17) which is provided on the proximal end side of the sheath and feeds liquid through the one flow channel inside the sheath towards the distal opening (paragraph 0014); and an opening for liquid feed which is formed in the support member, the opening being arranged around the slide hole (paragraph 0014 lines 3-5), communicating to the one flow channel (see Fig 1 and paragraph 0014) and partially blocking flow in the vicinity of the distal end portion (again, see Fig 1). Kokai also discloses the radio knife wherein the sheath has an extending portion extending ahead of the support member, the extending portion having an internal space, which stores the electrode portion (Fig 5). Kokai does

not disclose a plurality of openings or that the plurality of openings is arranged around the slide hole to prevent the rod-shaped portion from entering therein. The translation of Kokai is silent regarding the electrical conductivity of the support member.

Rexroth teaches an electrosurgical device (10) comprising an electrically insulating sheath (70, column 9 lines 3-5) having a flow channel inside (see Figs 13 and 14), a distal end portion and a proximal end portion, the distal end portion of the sheath having a distal opening and an axis (Fig 4). The insulation sheath inherently forms a support member which closes the distal opening of the sheath, and is insulating. The insulating tip defines a slide hole for the rod-shaped electrode shaft (50), the slide hole having a diameter smaller than that of the distal opening (Fig 14). The electrosurgical device of Rexroth has a liquid feed portion (18), and a plurality of openings (see Fig 6) for liquid feed (column 8 line 62- column 9 line 8) arranged around the electrode tip (column 8 lines 59-61), wherein the rod-shaped portion is inherently prevented from entering in the openings. Rexroth teaches that it is old and well known in the art to substitute a plurality of openings for one single opening in order to provide a superior flow pattern (column 8 line 62- column 9 line 8). It would have been obvious to one of ordinary skill in the art at the time the invention was made to have modified the device of Kokai by including a plurality of openings for liquid feed in order to create a superior flow pattern of liquid flow, as taught by Rexroth. Including the plurality of openings for liquid feed in the device of Kokai, the rod-shaped portion would necessarily be prevented from entering in the openings. It also would have been obvious to modify

Kokai by making the support member an electrically insulating tip in order to prevent short circuiting of the device, as taught by Rexroth.

Regarding claims 8 and 9, Kokai in view of Rexroth discloses the radio knife as described above, but does not disclose an extending portion of the rod-shaped portion extending across the extending direction of the rod-shaped portion or being hooked. Rexroth teaches a radio knife, as described, wherein the electrode portion (50) has an extending portion (26) located on the distal end portion of the rod-shaped portion and extending across the extending direction of the rod-shaped portion (Fig 15), and wherein the extending portion is a hooked bent portion (26C) extending substantially at right angles to the distal end portion of the rod-shaped portion (Fig 18). It would have been obvious to one of ordinary skill in the art at the time the invention was made to have further modified the device of Kokai by including the features taught by Rexroth, as described above, and by forming an extending portion of the rod-shaped portion as extending across the extending direction or as a hook in order to catch tissue around the extending portion.

Claim 10 is rejected under 35 U.S.C. 103(a) as being unpatentable over Kokai in view of Rexroth as applied to claim 8 above, and further in view of Kittur et al (US 5846241 ).

Kokai in view of Rexroth does not specifically disclose a platelike electrode. Kittur teaches a radio knife (10) wherein the extending portion (22) is a platelike electrode portion (24) coupled to the distal end portion of the rod-shaped portion (20). It would

have been obvious to one of ordinary skill in the art at the time the invention was made to have modified the invention of Kokai in view of Rexroth with the platelike electrode of Kittur because all three inventions are similar electrosurgical devices that perform similar functions. It would have been obvious to combine the three inventions in order to provide one device with an increased number of applications for which it can be used.

### ***Response to Arguments***

Applicant's arguments filed February 6, 2008 have been fully considered but they are not persuasive.

Applicant argues that Kokai does not disclose that the opening for liquid feed is arranged around the slide hole to prevent the rod-shaped portion from entering therein. Examiner has considered this argument, but has made a new rejection, making the argument moot.

In response to applicant's argument that the opening of Rexroth would not be able to be used to provide a reliable hemostatic treatment, a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim.

Applicant argues that a "slide hole" is not formed in Rexroth. Examiner maintains that the support walls 100-102, shown in Fig 12, create a slide hole. Applicant further argues that using the structure of the slide hole of Rexroth would create an unstable

electrode shaft, wherein it is difficult to slide the shaft smoothly. Applicant has not claimed these features. Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

Regarding Applicant's argument that Rexroth does not have "one flow channel," Examiner points out that if there are three flow channels, as suggested by Applicant, then there is also one flow channel.

Applicant argues that the wide openings disclosed by Rexroth would not provide the intended fluid flow of the instant invention. However, not specific size of the openings has been claimed. Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to JACQUELINE PAPAPIETRO whose telephone number is (571)272-1546. The examiner can normally be reached on M-F 8am-4:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Linda Dvorak can be reached on (571) 272-4764. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.



Art Unit: 3739

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Linda C Dvorak/  
Supervisory Patent Examiner, Art  
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/J. P./  
Examiner, Art Unit 3739